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No. 94-1131

In The
Supreme Court of the United States
October Term, 1994

Chrysler Corporation,
Petitioner,
v.
Robert W. Kearns,
Respondent.

On Petition for Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

MOTION FOR LEAVE TO FILE BRIEF AMICUS CURIAE AND BRIEF AMICUS CURIAE OF ARNOLD, WHITE & DURKEE IN SUPPORT OF RESPONDENT

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MOTION FOR LEAVE TO FILE BRIEF AMICUS CURIAE

Arnold, White & Durkee ("AW&D"), a Texas corporation, is a 120-attorney law firm with a national practice principally devoted to intellectual property litigation, including patents, trademarks, copyrights, and trade secrets. The respondent, Dr. Robert W. Kearns, is proceeding *pro se* in this action. AW&D retains a contractual contingent fee interest in Dr. Kearns' recovery in this case. For the following reasons, AW&D believes that its appearance to support the judgment below and to urge denial of the above petition will be of material benefit to the Court.

This case arises out of patent infringement litigation concerning Dr. Kearns' patents on intermittent windshield wiper control systems for automobiles. AW&D served as counsel to Dr. Kearns in a bellwether case against Ford Motor Company involving the same patents that are at issue in this case. AW&D also served as counsel to Dr. Kearns in the present case until one week before the trial was scheduled. Dr. Kearns retained another law firm, Reed, Smith, Shaw & McClay ("RSS&M"), to represent him during the infringement portion of the latter trial against Chrysler, but discharged that firm after Chrysler's infringement was established. Dr. Kearns then proceeded *pro se* during the damages phase of the Chrysler trial.

During the post-judgment motion period in this case, the District Court (E.D. Mich.) (Cohn, J.) requested that AW&D and RSS&M participate as amicus curiae in response to a 167-page motion by Chrysler to set aside the judgment or for a new trial. As amici, AW&D and RSS&M filed an extensive brief in the trial court that addressed the legal issues raised by Chrysler. In his 76-page post-trial opinion, Judge Cohn relied largely on the amicus brief, finding Dr. Kearns' two opposition briefs to be "unfocused and of little help." Pet. App. C-4. Judge Cohn's opinion concluded by stating that "[w]ithout the contribution of the amicus brief, the Court would still be struggling to come to a conclusion." *Id.* at C-78.

On Chrysler's appeal to the United States Court of Appeals for the Federal Circuit, AW&D was granted leave to participate as an amicus curiae and the Court of Appeals further granted AW&D leave to file a 50-page brief rather than the customary 20-page amicus brief. Thus, as previously and correctly recognized by both the trial court and the Federal Circuit, AW&D is a proper amicus curiae whose continued participation in this case should materially assist this Court in reaching a proper and just final resolution.

Counsel for petitioner Chrysler Corporation has consented to the filing of this brief; however, Dr. Kearns declined to give his consent. For the reasons set forth above, this motion for leave to file as amicus curiae should be granted.

Respectfully submitted,

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BRIEF AMICUS CURIAE OF ARNOLD, WHITE & DURKEE IN SUPPORT OF RESPONDENT

STATEMENT OF INTEREST OF AMICUS CURIAE

Arnold, White & Durkee ("AW&D"), a Texas corporation, is a 120-attorney law firm with a national practice principally devoted to intellectual property litigation, including patents, trademarks, copyrights, and trade secrets. The respondent, Dr. Robert W. Kearns, is the inventor of several patents concerning intermittent windshield wiper control systems for automobiles that are the subject of the present case. Dr. Kearns is currently proceeding *pro se* in this action, in which he charged Chrysler Corporation ("Chrysler") with infringing four of his patents.

AW&D served as counsel to Dr. Kearns in a bellwether case involving the same patents-in-suit, *Kearns v. Ford*

Motor Co., Civil Act. No. 78-70740 (E.D. Mich.) ("the *Ford* case"). That earlier case is significant here because, in order to stay proceedings in the present lawsuit, Chrysler agreed to be bound by a judgment against Ford as to the validity and enforceability of the same patents at issue here. AW&D was also Dr. Kearns' trial counsel in the present action until one week before the trial was scheduled. Following that trial, AW&D served at the specific request of the District Court as an amicus curiae throughout the post-trial motions phase of this case. AW&D later participated as an amicus curiae during Chrysler's appeal to the Court of Appeals for the Federal Circuit. AW&D has a direct stake in the outcome of this litigation because it retains a contractual contingent fee interest in Dr. Kearns' recovery in this case.

STATEMENT OF THE CASE

Because Chrysler's petition omits pertinent details surrounding the *Ford* case and regarding the stipulation by which Chrysler agreed to be bound by validity and enforceability determinations regarding Dr. Kearns' patents in that case, AW&D presents the following Statement of the Case. When the more complete facts are known, it becomes clear that Chrysler's petition should be denied.

I. Chrysler's Stipulation And The *Ford* Case

In his 1982 complaint, Dr. Kearns charged Chrysler with infringing four of his patents covering intermittent windshield wiper control systems for automobiles. In October 1982, this case was stayed by a district court order pursuant to the stipulation between Chrysler and Kearns in which Chrysler agreed to be bound by a "judgment as to the validity" of the same patents. Pet. App. A-2. In late 1989, before the *Ford* case went to trial, Chrysler and Kearns agreed to a second stipulation providing that "Chrysler shall be bound by the judgment (excluding a consent judgment) in the Kearns v. Ford case, C.A. No. 78-70740 as to the validity and enforce-

ability of the patents in that action that are also involved in this action." Pet. App. A-2 to -3. That stipulation was entered by the district court on February 15, 1990. *Id.* at A-3.

Chrysler agreed to the second stipulation on the condition that Dr. Kearns' suit against Chrysler be stayed until after the *Ford* case was completed. Pet. App. A-2. The liability phase of the Ford trial occurred in January 1990 and lasted over two weeks. Ford had access to and had identified all of the prior art references that Chrysler now complains were wrongfully excluded in this case. Even though Ford relied upon that prior art for its defenses, the jury returned a unanimous verdict that the contested claims of Dr. Kearns' patents were not invalid or unenforceable. Pet. App. A-3. Based on the jury's verdicts, District Judge Cohn entered a partial judgment that specified claims of Dr. Kearns' patents were valid, enforceable, and infringed by Ford. *Id.*

The first damages trial in the *Ford* case failed to achieve a unanimous verdict. After a second damages trial resulted in a verdict of $5,163,842 for the period of April 3, 1978 through 1988, Ford and Dr. Kearns later reached a settlement as to Ford's total liability from 1972 to 1988. Judge Cohn then entered a Final Judgment which stated that the prior partial judgment entered on the jury's verdicts of validity and enforceability was "made final." Pet. App. A-3. No appeals were taken.

II. The Trial Proceedings In This Case

Shortly before this trial was to commence (several months after the final judgment in the *Ford* case), Chrysler moved to add an invalidity defense, arguing that the settlement in the *Ford* case meant that the judgment on validity and enforceability was actually a consent judgment. Pet. App. A-4. Judge Cohn ruled that the *Ford* judgment on validity was actually litigated and that the liability issues had been "hotly," "vigorously," and "fully,"

contested during a lengthy jury trial. *See* Pet. App. A-8. The district court further stated that Chrysler's stipulation did not obligate Ford to have pursued all possible post-trial motions and have exhausted all rights of appeal. *Id.* at A-7 to -8.

After a four-week trial, the jury in this case found that Chrysler had infringed Dr. Kearns' patents and answered a multitude of special questions supporting its verdicts. In reviewing Chrysler's post-trial motion, the district court considered the claims, the jury instructions, the verdicts and the evidence in the record in reaching a 76-page decision that substantial evidence supported the jury verdicts. Pet. App. C.

The district court observed that "Chrysler's arguments regarding evidentiary rulings is [sic] difficult to discuss because they are long on law but short in describing the precise rulings to which exceptions were taken." Pet. App. C-55. The district court also noted that "Chrysler ignores the rule that entitlement to a new trial because of a wrong ruling on a matter of evidence requires a showing of prejudice." *Id.* In rejecting Chrysler's complaints, the court noted:

> Suffice to say, the Court did not exclude prior art as an aid to claim interpretation but rather excluded discussion of prior art in circumstances in which Chrysler was obviously trying to challenge the validity of the patents-in-suit.

Pet. App. C-56. Finally, the jury in this case was specifically instructed that the prior art evidence at trial could be used to determine the meaning of the terms in a claim. *Id.* at C-57.

With respect to the jury instructions in this case, the district court recounted the long and contentious process by which the jury instructions had been formulated among Chrysler, Dr. Kearns, and the court. Pet. App. C-35 to -43. Judge Cohn held that Chrysler had not complied

with the requirements of Fed. R. Civ. P. 51 that a party "stat[e] distinctly the matter objected to and the grounds of the objection." Moreover, he noted that Chrysler did not offer "any alternative text" for the instructions that had been objected to nor propose any instructions which interpreted the claims as having other than the plain meaning of the words of the claims. Pet. App. C-40, -42. After reviewing Chrysler's objections, the district court discerned no error or prejudice to Chrysler that justified a new trial.

III. Chrysler's Appeal To The Federal Circuit

Most importantly for present purposes, the Federal Circuit "reject[ed] Chrysler's attempts to avoid the consequences of its stipulation by redefining its terms." Pet. App. A-6 to -9, at A-8. Holding that neither Ford nor Dr. Kearns had "settled or agreed" on the issues of validity or enforceability, the Court of Appeals held that the *Ford* judgment was not a consent judgment as referred to in the stipulation. *Id.* at A-9 (citing Restatement (Second) of Judgments § 40 (1982)). Notably, Chrysler's present petition to this Court no longer disputes that the 1989 pretrial stipulation was properly construed to foreclose Chrysler from contesting the validity and enforceability of Dr. Kearns' patents in this case. *See* Pet. 7-8, 10.

The Court of Appeals also found no abuse of discretion in the exclusion of prior art evidence allegedly offered by Chrysler to interpret the claims. Pet. App. A-10. The Federal Circuit noted that "when claim language is clear and unambiguous on its face, resort to the prior art may be unnecessary." *Id.*

> The district court . . . concluded that the claims could be construed according to their plain meaning and that reference to prior art was not required. Moreover, and highly significant here, the district court believed that Chrysler's attempts to offer such evidence constituted a disguised, "back door" attack on

> the validity of the patents, which was expressly proscribed by the binding stipulation.

Id. at A-11 (footnote omitted). As explained in that footnote by the Court of Appeals, prior art is not needed to interpret limitations in "means-plus-function" format under 35 U.S.C. § 112, ¶ 6 (1988) because the presence of the same or equivalent structure in the prior art does not limit the scope of the claim. *See* Pet. App. A-11 n.7 (citing *Intel Corp. v. U.S. Int'l Trade Comm'n.*, 946 F.2d 821, 842 (Fed. Cir. 1991)).

When prior art is not required to interpret the claims, "[s]uch evidence is by definition 'irrelevant' and need not be admitted by a trial court." Pet. App. A-10 (citing Fed. R. Evid. 401, 402). The Court of Appeals concluded that the "district court's reasoning adequately supports its refusal to admit the proffered evidence." Pet. App. 11.

> Moreover, even if the [district] court committed error in not admitting any particular prior art evidence, we have not been persuaded that the claims were erroneously construed and that Chrysler was thereby prejudiced.

Pet. App. A-11. On those multiple grounds, the Federal Circuit affirmed the denial of Chrysler's motion for a new trial. *Id.* The Court of Appeals also rejected Chrysler's appeal from the denial of its motion for judgment as a matter of law on the issue of infringement. Pet. App. A-11 to -14. The infringement issue is not part of Chrysler's current petition.

SUMMARY OF THE ARGUMENT

Because Chrysler's petition does not raise any factual or legal issues with importance beyond the resolution of the parties' controversy, the petition should be denied. The discretionary evidentiary rulings made by the district court in this case result directly from the specific facts at issue between Chrysler and Dr. Kearns; *i.e.*, the meaning and effect of Chrysler's stipulation to be bound by the prior outcome on validity and enforceability in the *Ford* case. However, Chrysler no longer challenges the preclusive effect of its pretrial stipulation.

A decision to admit or exclude evidence at trial is only reviewed for an abuse of discretion and can only be reversed for substantive prejudice to the affected party. Chrysler's petition fails on both prongs. As to the former, Chrysler only makes the legally erroneous assertion that no discretion to exclude prior art evidence existed in this case at all. Not only is that position wrong, but Chrysler simply ignores that the Court of Appeals held, "even if the [district] court committed error in not admitting any particular prior art evidence, we have not been persuaded that the claims were erroneously construed and that Chrysler was thereby prejudiced." Pet. App. A-11. Chrysler failed to show prejudice arising from any particular ruling. Because Chrysler's petition raises only one of the two pertinent prongs, it does not provide adequate grounds on which to grant review.

Not only does a trial court retain discretion to exclude evidence of prior art offered for purposes of claim construction, but affirmance of that basic proposition does not warrant granting certiorari in this case. Chrysler's contrary position is based on a misreading of a single case, *Westinghouse Elec. & Mfg. Co. v. Formica Insul. Co.*, 266 U.S. 342 (1924). However, the permissive terms in the *Westinghouse* opinion demonstrate that this Court intended there to be discretion as to the admissibility of prior art evidence. The facts of this case fit the Court's

rationale in *Westinghouse* and further parallel the very situation that this Court foresaw in 1924 as justifying the exclusion of prior art evidence. Finally, *Westinghouse* can have no effect on the proper method of interpreting the "means-plus-function" limitations in Dr. Kearns' patents because such limitations were first allowed by statute 28 years after that case was decided.

Because Chrsyler's petition is based on a faulty legal premise, it can only be denied. Where a party such as Chrysler agrees to be bound by the validity and enforceability outcomes in a prior lawsuit in which prior art evidence was admitted for purposes of claim interpretation, no prejudice results from foreclosing that party from having an unwarranted "second bite at the apple." In short, the courts below properly prevented Chrysler's ill-disguised "back door" attack on the validity of Dr. Kearns' patents.

Chrysler's remaining assertions merit little additional response. Nothing has been improperly removed from the public domain because the claims at issue were held to be valid in the *Ford* case during which all prior art known to Chrysler at the time was available as evidence. Indeed, Chrysler still has not made a specific showing of how any particular prior art would have read upon Chrysler's accused systems or how any excluded prior art evidence would have altered the result in this case. To the extent that Chrysler wishes it had requested detailed jury instructions in this case based on the outcome in the *Ford* case, such objections were never made at trial and have thus been waived.

ARGUMENT

I. CHRYSLER'S PETITION CAN BE DENIED BECAUSE IT DOES NOT RAISE ANY ISSUE WITH SIGNIFICANCE BEYOND THE DISPUTE BETWEEN THE PARTIES IN THIS CASE

The district court's evidentiary rulings at issue arose directly from Chrysler's pretrial stipulation to be bound by any prior judgment on the validity and enforceability of the patents-in-suit reached in the prior *Ford* case. *See* Pet. App. A-9 to -12. Without doubt, the interpretation and significance of that stipulation have no legal consequences apart from the present facts. Although Chrysler weakly tries to characterize the Federal Circuit as having given an erroneous "signal" as to the admissibility of prior art evidence in future patent cases, Pet. 12, Chrysler's petition actually presents nothing more than post-trial assertions that a district judge abused his discretion when excluding some of the losing party's evidence in a particular case.

Routine evidentiary rulings rarely merit further review by this Court, particularly where both lower courts are in agreement as to the propriety of the challenged rulings. This case is no exception. Moreover, the discretionary rulings challenged by Chrysler's petition have no precedential implications beyond their belated contribution to resolving the longstanding dispute between Chrysler and Dr. Kearns. *Cf. Rudolph v. United States*, 370 U.S. 269 270 (1962) (dismissing a writ as improvidently granted when the issue presented involved review of a factual matter that "would be of no importance save to the litigants themselves"). For that reason alone, Chrysler's petition should be denied.

II. CHRYSLER'S PETITION DOES NOT ADDRESS THE FINDING OF NO PREJUDICE TO CHRYSLER, WHICH IS AN INDEPENDENT BASIS FOR AFFIRMING THE JUDGMENT

A trial court's evidentiary decisions are reviewed for an abuse of discretion and, if such an abuse is shown, are only reversed where the exclusion prejudiced that party's substantive rights. *See* Pet. App. A-10 (and cases cited). Just as occurred before the district court, *e.g.*, Pet. App. C-55, Chrysler's petition to this Court ignores that proof of prejudice to Chrysler must be provided in addition to a showing of an abuse of discretion (or a lack of discretion).* By only seeking certiorari on the scope of the district court's discretion to exclude prior art evidence, Chrysler's petition is therefore insufficient on its face to allow this Court to grant the requested writ on the limited grounds requested. *See, e.g., The Monrosa v. Carbon Black Export, Inc.*, 359 U.S. 180 (1959) (deciding the ground upon which a grant of certiorari was premised was unnecessary where the underlying judgment was clearly correct on another ground).

There is no basis for overturning the district court's repeated findings that Chrysler was not prejudiced by the district court's evidentiary rulings concerning the admissibility of prior art evidence. *See* Pet. App. C-57 to -62. The same judge presided over the *Ford* case and over this case. Pet. App. A-8 n.6. Judge Cohn was well aware of the events and results in the *Ford* case, and knew that patent claims are to be given the same construction when considering infringement as when considering validity. *See, e.g., Intervet America, Inc. v. Kee-Vet Laboratories, Inc.*, 887 F.2d 1050, 1053 (Fed. Cir. 1989); *see also White v. Dunbar*, 119 U.S. 47, 51-52 (1886) (a patent claim should not be treated like a "nose of wax"). No

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* As shown in section C *infra*, Chrysler also failed to convince the district court or the Court of Appeals of any abuse of discretion in this case, and has offered no reason to allow this Court to reach a different conclusion.

one was in a better position than Judge Cohn to ensure that the jury's claim interpretation and infringement findings in this case did not conflict with the prior jury's claim interpretations and findings in the *Ford* case. As confirmed by the Court of Appeals, no such conflict has been shown.

Not only did the district court and the Federal Circuit properly conclude that Chrysler was bound by its prior stipulation, but the Federal Circuit specifically held that the district court's decision to exclude certain prior art evidence was at most harmless error that did not prejudice Chrysler.

> Moreover, even if the [district] court committed error in not admitting any particular prior art evidence, we have not been persuaded that the claims were erroneously construed and that Chrysler was thereby prejudiced.

Pet. App. A-11. Chrysler's petition barely acknowledges that separate and independent basis for upholding the district court's evidentiary ruling. *See* Pet. 10 n.8.

Claim construction is a matter of law which is reviewed *de novo* on appeal. *See, e.g., Texas Instruments Inc. v. U.S. Int'l Trade Comm'n*, 988 F.2d 1165, 1171 (Fed. Cir. 1993). Chrysler has not challenged the Federal Circuit's conclusion that prior art was not required to interpret the plain language of the claims or the Federal Circuit's independent analysis of the claim language. Regardless of the merits of Chrysler's manufactured criticism of the district court's decision to exclude certain prior art evidence at trial on the basis of Chrysler's stipulation, there remains no basis on which to reverse the judgment in this case. Thus, even if this Court were to undertake a review of a particular result in an individual case, no such review would be warranted here.

III. THE *WESTINGHOUSE* DECISION FULLY SUPPORTS THE RULINGS AND JUDGMENT IN THIS CASE

Chrysler bases its petition on the misplaced premise that the Court of Appeals "misread" this Court's decision in *Westinghouse Elec. & Mfg. Co. v. Formica Insul. Co.*, 266 U.S. 342 (1924). Pet. 7-12. In doing so, Chrysler mischaracterizes *Westinghouse* as holding that a district court has no "discretion" to exclude any prior art evidence offered in a patent case for purposes of construing the claims of the patent(s)-in-suit. Pet. 12. No such rule was announced in *Westinghouse*. No such rule exists under the Federal Rules of Evidence. Thus, because it is only Chrysler that is guilty of misreading *Westinghouse*, there is no basis for granting certiorari in this case.

Westinghouse involved "assignor estoppel," a doctrine that operates to prevent an assignor-inventor from assigning a patented invention to another for value and then attempting to prove during subsequent litigation that the assigned patent is actually invalid (*i.e.*, worthless). *See, e.g., Shamrock Technologies, Inc. v. Medical Sterilization, Inc.*, 903 F.2d 789, 793-94 (Fed. Cir. 1990); *Diamond Scientific Co. v. Ambico, Inc.*, 848 F.2d 1220 (Fed. Cir.), *cert. dismissed*, 487 U.S. 1265 (1988). While the present case does not involve assignor estoppel at all, the reasoning in *Westinghouse* shows that the Federal Circuit's analysis and the district court's actions in this case were entirely proper.

In concluding that prior art evidence could be admitted for claim interpretation purposes by an assignor who was foreclosed from directly challenging the validity of the patent-in-suit, this Court offered the following analysis in *Westinghouse*:

> We think, however, that the better rule, in view of the peculiar character of patent property is that the state of the art *may* be considered. Otherwise the most satisfactory means of measuring the extent of the grant the government intended and which the assignor as-

> signed would be denied to the court in reaching a just conclusion. Of course, the state of the art cannot be used to destroy the patent and defeat the grant, because the assignor is estopped to do this. But the state of the art *may* be used to construe and narrow the claims of the patent, conceding their validity. The distinction may be a nice one but seems to be workable. *Such evidence might not be permissible in a case in which the assignor made specific representations as to the scope of the claims and their construction*, inconsistent with the state of the art, on the faith of which the assignee purchased; but that would be a special instance of estoppel by conduct.

266 U.S. at 350-51 (emphasis added). When fairly read, the above passage proves that the Federal Circuit's decision is not in conflict with *Westinghouse* and that *Westinghouse* does not eliminate a district court's discretion to exclude prior art evidence in patent cases.

First, nothing in *Westinghouse* supports Chrysler's contention that all prior art evidence must always be considered. Indeed, the Court's use of the permissive terms "may" and "might" and "permissible" demonstrates that the Court recognized and intended that a district court would retain its usual discretion regarding the admissibility of trial evidence. *See, e.g., Haig v. Agee*, 453 U.S. 280, 294 n.26 (the term "may" expressly recognizes substantial discretion); *cf. Donovan v. Burlington Northern, Inc.*, 781 F.2d 680, 682-83 (9th Cir. 1986) (construing this Court's use of permissive "may assess attorneys' fees" rather than mandatory phrase in *Alyeska Pipeline Service Co. v. Wilderness Society*, 421 U.S. 240, 258 (1975), as a strong suggestion that the Court meant to entrust the issue to the sound discretion of district courts).

As recognized by the Court of Appeals, a trial judge always has discretion to admit or exclude evidence at trial on multiple grounds, such as relevancy, authenticity, prejudice, or redundancy. Pet. App. A-10. Patent cases are the same as any other type of case, and *Westinghouse*

offers no overriding maxims to alter that discretion. Moreover, the claims at issue use limitations written in "means-plus-function" format under 35 U.S.C. § 112, ¶ 6 which do not need any consideration of prior art for proper interpretation. *See* Pet. App. A-11 n.7. Although Chrysler ignores that footnote, it should be noted that section 112-6 was not enacted by Congress until 1952 (nearly thirty years after *Westinghouse*). Thus, nothing in the *Westinghouse* opinion should or can be construed as requiring a district court to allow a jury faced with construing "means-plus-function" limitations to consider prior art evidence that is not necessary as a matter of law.

The Court in *Westinghouse* specifically observed that "[prior art] evidence might not be permissible in a case in which the assignor made specific representations as to the scope of the claims and their construction." 266 U.S. at 351. That is fatal to Chrysler's current position. This Court would not announce a new "absolute" rule for admissibility of all prior art evidence while simultaneously describing a specific situation in which a district court could elect to exclude such evidence. Contrary to Chrysler's strained reading, not only does a district court retain the discretion under *Westinghouse* to determine when such evidence may or may not be admitted, but the Federal Circuit correctly found that no abuse of discretion occurred in this case.

Perhaps more importantly, the express exception cited in *Westinghouse* directly parallels the facts of the present case. In *Westinghouse,* this Court stated that an assignor that makes specific representations as to the scope of the assigned claims and their construction may be foreclosed from introducing evidence contrary to those representations. 266 U.S. at 351. In this case, Chrysler represented to Dr. Kearns and to the district court that the scope of the patent claims at issue would be as determined in the proceedings in the *Ford* case. Under the reasoning of *Westinghouse,* Chrysler cannot reap the value of its stip-

ulation and then be allowed to eliminate any value of that same stipulation to Dr. Kearns.

Chrysler is no different than one who assigns a patent for value and then attempts to negate that value in later litigation. In exchange for Dr. Kearns' agreement to the stipulation, Chrysler received the value of a nine-year stay of proceedings. Moreover, if Ford had succeeded in its validity or enforceability defenses against the Kearns patents, Dr. Kearns likely would not have been able to assert those same claims against Chrysler. *See Blonder-Tongue Lab., Inc. v. University of Illinois Found.*, 402 U.S. 313 (1971). When Ford did not succeed, however, Chrysler was properly foreclosed from contesting the validity and enforceability of those same claims as a result of the representations as to claim scope in its stipulation. The Court of Appeals correctly upheld the trial court's rulings that stopped Chrysler from making a "back door" attack on the validity of the patents as expressly proscribed by Chrysler's binding stipulation. Pet. App. A-11.

IV. THE CLAIMS AT ISSUE WERE FULLY CONSTRUED IN LIGHT OF THE PRIOR ART AND DO NOT TAKE ANYTHING AWAY FROM THE PUBLIC

Chrysler argues that subject matter has been improperly removed from the public domain. Pet. 12-14. That is simply not true. Dr. Kearns' patent claims were affirmed as being valid in the *Ford* case. Valid claims cannot cover something in the public domain, so valid claims do not remove matter from the public domain. *See Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1573 (Fed. Cir.), *cert. denied*, 481 U.S. 1052 (1987). Because the claims at issue were adjudged valid in the *Ford* case, and because Chrysler agreed to be bound by that judgment, Chrysler's assertion that something has been improperly taken away from the public is nonsensical. Chrysler's argument is nothing more than a semantic effort to avoid the issue preclusion arising from its own stipulation.

Chrysler's petition similarly asserts that Chrysler was wrongfully "precluded from showing that its accused windshield wiper system was identical to the prior art in every detail relevant to Kearns' claim of infringement." Pet. 3. As previously observed by the district court, Chrysler's plea of error is long on rhetoric but short on substance. *See* Pet. App. C-55. Although reciting certain prior art references in its Statement Of The Case, Chrysler still has not made any showing as to how those alleged prior art systems would read on Chrysler's accused windshield wiper systems. Moreover, Chrysler misleads this Court by suggesting that it is enough merely to show that the individual features of the patented invention existed in the prior art. *See* Pet. App. C-7 (citing *Environmental Designs Ltd. v. Union Oil Co. of Calif.*, 713 F.2d 693, 698 (Fed. Cir. 1983), *cert. denied,* 464 U.S. 1043 (1984)).

Unlike the situation in *Westinghouse,* the claims of the patents at issue in this case were actually and fully construed in light of the prior art—in the *Ford* case. The 20 days of that trial provided ample opportunity for Ford to introduce abundant prior art references in support of its proffered claim construction and its asserted invalidity, unenforceability, and noninfringement defenses. Moreover, Chrysler's attorneys were in attendance during the entire *Ford* trial and consulted with Ford's counsel prior to and during trial. If there was any prior art that Chrysler has any reason to believe was relevant to the construction of the Kearns patent claims, such art surely was brought to the attention of Ford at that time. Thus, in contrast to the situation in *Westinghouse,* the patents in this case were fully and fairly interpreted in light of the prior art.

To the extent that Chrysler is complaining for the first time to this Court that the jury in this case did not receive sufficient guidance in Judge Cohn's instructions as to the construction given to the claims at issue by the jury in

the *Ford* case, the time for such complaints has long since past.

> No party may assign as error the giving or the failure to give an instruction unless the party objects thereto before the jury retires to consider its verdict, stating distinctly the matter objected to and the grounds of the objection.

Fed. R. Civ. P. 51; *see* Pet. App. C-44. Only Dr. Kearns attempted to provide an instruction for use in this case as to what the jury in the *Ford* case had found to be the proper interpretation of the claims at issue. *See* Pet. App. C-40. Because Chrysler did not object to the lack of a specific jury instruction regarding the claim interpretation reached in the *Ford* case, that basis for attacking the jury's verdict has been lost. *See Springfield v. Kibbe,* 480 U.S. 257, 258 (1987).

Finally, Chrysler makes the outlandish assertion that "[n]either the trial court nor the Federal Circuit expressed any doubt that Chrysler's accused system was identical to the prior art for all purposes relevant to the application of the claims." Pet. 7. That is baseless. Neither court made any statement that even insinuated that Chrysler's accused windshield wiper systems were or could be found in the prior art. Instead, both courts confirmed the jury's verdicts that Chrysler infringed the asserted claims of Dr. Kearns' patents, which had already been held valid and enforceable over the prior art in the *Ford* case. Chrysler's petition presents no arguable basis for altering that correct and overdue result in this case.

CONCLUSION

For the foregoing reasons, this Court should deny Chrysler's petition for writ of certiorari.

Respectfully submitted,

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